

## **REMARKS**

Claims 34-39 and 41 are pending. No new matter has been added.

Applicants reserve the right to prosecute the subject matter of any previously canceled, withdrawn or amended claim or any other unclaimed subject matter in one or more related applications.

### **I.        Rejection of Claims 34-39 and 41 Under 35 U.S.C. § 112, First Paragraph**

Claims 34-39 and 41 have been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Applicants respectfully traverse this rejection.

There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263 (C.C.P.A. 1976). Indeed, the rejection of an original claim for lack of written description should be rare. M.P.E.P. § 2163. Furthermore, the Examiner has the initial burden of presenting reasons or evidence why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. *Id.*

Applicants submit that the Examiner has not provided any reason or evidence as to why the present claims allegedly lack written description other than conclusory statements. In particular, the Examiner has merely stated that the definitions of the groups of the compounds recited in the pending claims encompass heterocyclalkyl and/or heterocyclic ring systems comprising five to six-membered heterocycle fused to phenyl, 3-8 member nitrogen-containing heterocyclic alkyl and that the number of structural variations is almost limitless. The Examiner's position appears to be that certain chemical definitions have breadth; however, Applicants respectfully submit that "breadth" is not a proper basis for rejection. *Application of Wakefield*, 422 F.2d 897, 904-905 (C.C.P.A. 1970).

Applicants respectfully submit that an applicant may satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, by disclosure of structural chemical formulas that are sufficiently detailed to show that the applicant was in possession of the claimed invention as a whole. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991); M.P.E.P. § 2163. Furthermore, with respect to claims involving chemical materials, the Federal Circuit has specifically stated that generic formulae usually indicate with specificity what the generic claims encompass because one skilled in the art can distinguish such a formula from others and can identify many of the species that the claims encompass. *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568 (Fed. Cir. 1997); *Application*

of *Herschler*, 591 F.2d 693, 699 (C.C.P.A. 1979) (“It is not necessary that the application described the claim limitations exactly, but only so clearly that one having ordinary skill in the pertinent art would recognize from the disclosure that appellants invented processes including those limitations”).

Applicants respectfully submit that one skilled in the art would recognize from the terms “heterocyclalkyl,” “heterocyclic ring systems comprising five to six-membered heterocycle fused to phenyl,” and “3-8 member nitrogen-containing heterocyclic alkyl” that Applicants were in possession of compounds within the generic chemical formulae reciting these groups. Furthermore, Applicants note that definitions for five or six-membered heterocycle and heterocyclealkyl groups are provided in the specification as filed at least at page 12, lines 14-22. In addition, the definition of five or six-membered heterocycle recites several representative examples of such groups, such as pyridinyl, pyrimidinyl, furanyl, thienyl, triazenyl, imidazolyl, thiazolyl, pyrazolyl, pyridazinyl and pyrazinyl. Applicants respectfully submit that these definitions are clear to one skilled in the art.

The Examiner has further stated that the biological activity would be affected by bulky R groups and that steric hindrance is a factor that affects the sensitivity of the receptor. Applicants respectfully submit that no evidence to support these statements has been provided. However, even if such statements were correct, Applicants respectfully submit that they are not germane to whether or not the pending claims satisfy the written description requirement. In other words, Applicants respectfully submit that the effect of certain substituents on biological activity is not relevant to whether or not such substituents are adequately described.

The Examiner has cited *Fujikawa v. Wattanasin* and *In re Ruschig* for the proposition that the disclosure of a genus does not provide written description for every subgenus or species within the genus, because it may not reasonably lead those skilled in the art to any particular subgenus or species. *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571 (Fed. Cir. 1996); *In re Ruschig*, 379 F.2d 990, 995 (C.C.P.A. 1967). Applicants respectfully submit that the facts of these cases are quite different than those of the present case. In particular, the issue in *Fujikawa v. Wattanasin* and *In re Ruschig* was whether or not a genus provided adequate written description support for a later claimed subgenus or species, respectfully, wherein the later claimed subgenus and species were not specifically disclosed in the application as filed (*i.e.*, whether or not those skilled in the art would be reasonably led to the later claimed subgenus or species by the genus originally disclosed in the application as filed). To the contrary, in the present case there is no issue of whether or not those skilled in the art would be “reasonably lead” to the presently claimed genus since it was specifically disclosed in the

application as filed. Accordingly, Applicants respectfully submit that the holdings of *Fujikawa v. Wattanasin* and *In re Ruschig* do not support the rejection of the pending claims for lack of adequate written description.

For the reasons set forth above, Applicants respectfully submit that the rejection of claims 34-39 and 41 under 38 U.S.C. § 112, first paragraph, has been overcome and should be withdrawn.

### **Conclusion**

Applicants authorize payment of the fee due in connection with a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for two (2) months from February 2, 2008 up to and including April 2, 2008, estimated to be \$460.00; should the USPTO determine that any additional fee is required, Applicants hereby authorize that the required fee be charged to Jones Day Deposit Account No. 50-3013.

Date: April 2, 2008

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